

Appln. No. 10/767,487
Amendment dated February 1, 2005
Reply to Office Action mailed November 2, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 5 remain in this application. Claim 6 has been cancelled. Claim 7 has been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 through 4 of the Office Action

Claims 1-5 have been rejected under 35 U.S.C. §102(b) as being anticipated by Pettit (US 5,135,308).

Claim 6 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Pettit in view of McDonough et al (US 6,086,360).

It is submitted that the combination of Pettit with McDonough is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "a supplemental handle extending from a medial portion of said elongated extension member in spaced relationship to said main gripping member such that said supplemental handle is positioned between said main gripping member and said holster to facilitate handling and controlling movement of said elongated extension member during us". The Pettit reference teaches an extended-handle lighter that fails to teach a supplemental handle extending from the medial portion of the elongated extension member and is positioned between the main gripping member and the holster to allow increased control of the lighter as claimed by the applicant. The McDonough reference teaches a utility lighter that fails to teach a supplemental handle extending from the medial portion of the elongated extension member and is positioned between the main gripping member and the holster to allow increased control of the lighter as claimed by the applicant. Further, the Office Action states column 8, lines 9 through 67 of

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the McDonough reference discloses a supplemental handle when the reference fails to provide any teaching of a supplemental handle and merely makes reference to the primary handle of the reference and therefore fails to provide any motivation for modification of the Pettit to incorporate a supplemental handle as claimed by the client. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)

(emphasis in original).

Therefore, it is submitted that the combination of Pettit reference with the McDonough reference would not lead one to the combination of features as claimed by the applicant.

Claims 2 through 5 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2 through 5 are also believed to be allowable over the cited reference.

Claim 6 has been cancelled.

Withdrawal of the §102(b) rejection of claims 1-5 is therefore respectfully requested.

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Withdrawal of the §103(a) rejection of claim 6 is therefore respectfully requested.

New Claims:

New claim 7 has been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Claim 7 incorporates the limitations of Claims 1 through 6 and as discussed above the cited references, specifically that of Pettit and McDonough, fail to provide any motivation for the use of supplemental gripping member positioned between the main gripping member and the holster as claimed by the applicant. Therefore, no new matter has been added. The new claim is believed to be allowable.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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